

The examiner cited *In re Orita*, 550 F2d 1277, 193 USPQ 145 (CCPA 1977) in support of her position.

There are two separate and very different issues raised by the Examiner. These are:

(A) was the Reissue Declaration submitted by the applicant sufficient as a matter of law and

(B) if the Reissue Declaration is meets the requirements of the statute and rules, are the facts distinguishable from *Orita* so that the claims should be allowed. Since these issues are quite different, I will address each separately.

(A) Was The Reissue Declaration Submitted By The Applicant Sufficient As A Matter Of Law

The applicant's attorney apologizes for submitting the wrong Declaration. Very recently there has been a great turnover in the clerical staff and the new members are inexperienced resulting in the wrong declaration being filed. Enclosed is a Reissue Declaration which in the opinion of the undersigned, meets the requirements of the statute and rules.

(B) Assuming the Reissue Declaration Meets The Requirements Of The Statute And Rules, The Facts Of The Present Situation Are Clearly Distinguishable From *Orita*.

In *Orita*, the error the applicant relied upon was that there was a restriction requirement pursuant to 35 USC §121, the applicant made an election, later cancelled the non-elected claims and forgot to file a divisional patent application for the non-elected invention (claims).

In *Orita*, the Board held:

that, under the circumstances of this case, failure to file a timely divisional application cannot be corrected by reissue.

at 147, 148. The CCPA affirmed. An important reason why the CCPA affirmed was that if they did not affirm but permitted a reissue, then copendency requirement would become meaningless, see [3] at 149.

The facts of the present case are almost the opposite of *Orita*. In the present case there was NO restriction requirement. The only prosecution was:

(1) 96-7-29 Paper No 3 – a rejection of claims 1-7 under 35 USC §112 and an objection to claims 2-6, 8 and 9

(2) 96-11-4 Reply and Amendment

(3) 96-12-31 Paper No. 7 - Notice of Allowability of claims 1-8.

There was NO restriction requirement at any time.

One of the public policy reasons for reissue applications is so an applicant who had the right to claim certain subject matter and did not do so, can within the two year period for broadening reissue, claim it. Admittedly, this is a broadening reissue. The applicant had §112 support for the subject matter of claims 9 thru 12, but did not claim these four compounds. The public policy behind the statute is to permit an applicant to do exactly what the applicant here is doing.

Permitting this reissue and allowing claims 9-12 will not affect the copendency requirement. In fact, the law specifically give an applicant two years to file the reissue. The applicant here has complied with the statute. The patent issued 97-7-29 and the reissue application was file 99-5-13.

III. Conclusion

Since the applicant has now submitted the proper Reissue Declaration, claims 9-12 should now be allowed.

Respectfully,

PHARMACIA AND UPJOHN

Date: 00-4-7

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6. In the case of interference proceedings, to make preliminary statements on behalf of the applicant or patentee, and to consent to concessions of priority, disclaimers of invention and abandonments of contest on behalf of Company;
7. Consent of Company assignee to the addition, removal or change of inventors in patents or patent applications;
8. Declaration of Ownership;
9. Petition for Extension of Patent Term.

The signature of the delegates identified above shall constitute complete and formal execution of the document by the Company.

PHARMACIA & UPJOHN COMPANY

By: Jack J. Jackson
Jack J. Jackson
Title: Senior Vice President
Date: 5-2-99

I hereby certify that Jack J. Jackson, who has signed the above delegation of authority, is a lawful representative of Pharmacia & Upjohn Company and is authorized to execute this document on behalf of Pharmacia & Upjohn Company, said Company having a place of business in Kalamazoo, Michigan (Address: 7000 Portage Road, Kalamazoo, Michigan 49001).

By: Robert J. Meisenhelder II
Robert J. Meisenhelder II
Title: Assistant Secretary
Date: May 12/1999